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The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING  
2 UNITED STATES PATENT AND TRADEMARK OFFICE  
3

4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7 MARC EPSTEIN, MARK COLLINS, PETER BARCLAY,  
8 BRIAN KARNEY, and GLENN RICART

9 Appeal 2010-003313

10 Application 09/750,500

11 Technology Center 2400  
12

13 Oral Hearing Held: Wednesday, September 14, 2011  
14

15  
16  
17 Before ALLEN R. MacDONALD, KALYAN K. DESHPANDE, and  
18 ERIC B. CHEN, Administrative Patent Judges  
19

20 ON BEHALF OF THE APPELLANT:  
21

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1                   *The above entitled matter came on for oral hearing on*  
2                   *Wednesday, September 14, 2011, commencing at 1:34 p.m., at the U.S.*  
3                   *Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia,*  
4                   *before Lori Allen, Notary Public.*

5  
6                   JUDGE MacDONALD: A couple of items before we begin.  
7                   Have you been here before?

8                   MR. KAPLAN: I argued one appeal, but it was many, many  
9                   years ago.

10                  JUDGE MacDONALD: I'll walk through the rules. You have  
11                  20 minutes, and typically, we would let you start at this point. I think this is  
12                  going to be something unusual because we have reviewed the record, and we  
13                  agree that it's not a § 102. However, we have agreed that it should have been  
14                  a § 103 rejection. We're going to give you the option of either waiting for  
15                  our decision or if you want, we can discuss whether we are getting that  
16                  wrong.

17                  MR. KAPLAN: Let me ask a question, if I may, before I  
18                  respond to that. I'd like to -- I'm familiar enough with the art that I would  
19                  like to address the 103, and I probably can. However, I would like to know  
20                  that I'm not waiving my right to address it, once your decision comes out,  
21                  because I haven't seen it.

22                  JUDGE MacDONALD: No, you're waiving nothing. This is  
23                  basically a free bite at the apple if you choose to take it. Let me quickly  
24                  indicate why we are of that view.

25                  The primary reference we thought did teach much of the  
26                  functionality, but was, as indicated, silent on what's prohibited. We  
27                  reviewed that in a narrow way. Even though you amended the claim to say  
28                  prohibiting --

29                  MR. KAPLAN: I'm sorry.

30                  JUDGE MacDONALD: We felt that it had to be interpreted as  
31                  one way versus two way trusts, that it wasn't prohibiting in any other sense.  
32                  That is what was disclosed explicitly.

1           The question for us was would someone know to use as one  
2 way, a one-way trust, something that is known in the art. What is it and  
3 what is a two way trust.

4           MR. KAPLAN: Okay.

5           JUDGE MacDONALD: That's a question we asked ourselves,  
6 and our determination from looking at the reference to Brown, Patent  
7 7,103,784, the Assignee is Microsoft, and what we rely on is just the two  
8 paragraphs, the first two full paragraphs in Column 3, which simply explain  
9 what a two-way trust is and explains what an one-way trust is.

10          MR. KAPLAN: I don't have the entire earlier record with me.  
11 Was this reference already --

12          JUDGE MacDONALD: Yes. All it indicates that I thought  
13 was critical was a two-way trust relationship is two one-way trust  
14 relationships, and the prior art showed using two-way trusts or allowing one  
15 server to talk to one client, and I think you have already indicated in the  
16 record that you're not trying to claim having extra servers.

17          The question for us becomes would it be obvious to set up  
18 known one-way trusts in the way the client has set them up.

19          MR. KAPLAN: Okay. Obviously, all I can address is the one  
20 because I haven't seen the other one. Maybe since --

21          JUDGE MacDONALD: I think I understand what you are  
22 doing. I think that is very reasonable. We have to supply what's missing. If  
23 you could convince us we don't have what's missing.

24          MR. KAPLAN: One thing I wanted to point out about  
25 Erpeldinger -- let me start with two concepts, if I might. I'm not sure exactly  
26 how this would factor into the § 103, again, I haven't seen it, but maybe it  
27 will help with whatever you come out with.

28          There are two huge misconceptions, in our view -- not  
29 misconceptions -- differences of view between the Examiner and us about  
30 Erpeldinger and how it relates to the claim. We actually think, and looking  
31 at it even more right before this argument, that it is teaching away, and that  
32 might even factor into the § 103, it is pretty clearly teaching away.

1           The first thing to distinguish is separate which way data is  
2     exchanged or commands or information when a computer connects to a  
3     server. We're not talking here about whether the data flows one way or  
4     commands the other way. Data and commands can flow either which way.  
5     We don't care about that.

6           We're talking about when something connects to something  
7     else, that the something else has enough information to authenticate and trust  
8     the thing that's connected, that he is who he says he is.

9           If I may just complete --

10          JUDGE MacDONALD: Let me read one sentence from the  
11     other reference, which I think I agree with what you're saying and where  
12     you're going, the Microsoft document indicates that in an one-way trust, one  
13     domain trusts the other domain-- it's very different than what the Examiner  
14     was talking about.

15          MR. KAPLAN: An one way trust is your ATM. Forgive me, I  
16     don't know if you go by Your Honor or sir.

17          JUDGE MacDONALD: Judge MacDonald.

18          MR. KAPLAN: Judge MacDonald, a one-way trust is your  
19     ATM card, right? The machine knows it's you because only you know the  
20     password.

21          The thing I wanted to point out is we're not talking about which  
22     way data or commands -- we're talking about access control. Number two,  
23     this goes to your issue about prohibiting, when we talk about prohibiting and  
24     when the later claims talk about separating the servers, we're talking about a  
25     situation where if a server provides some services to a client that involved  
26     the client giving log on and authentication information to the server, that we  
27     ensure that server does not provide services to that client that involve the  
28     server providing log on or authentication information to the client, the other  
29     way.

30          I want to point out something in Erpeldinger that was not in our  
31     brief, and to be frank, it's because I just caught it. Erpeldinger -- let me turn

1 to the first of those issues. The Examiner's position -- let me find the exact  
2 place on the brief, the Examiner's brief.

3 The Examiner states in its brief, at page eight of the Examiner's  
4 brief -- I'm sorry -- page nine, about the third line down, "There is nowhere  
5 in the reference, " referring to Erpeldinger, "That even suggests that the  
6 client work station is capable of accessing or even sending data to the  
7 distribution server."

8 He concludes from that that you can't have access. What his  
9 reasoning here is since the distribution server is distributing software to the  
10 client, the server logs onto the client with secure access and distributes the  
11 software that way. That's confusing the flow of information with the access.  
12 The access is affirmatively taught to be the other way.

13 If you look at claim 11 in Erpeldinger, claim 11 says "A method  
14 of changing a current operating system to a new operating system in a work  
15 station," and then he goes on to say "Using a data transmission network to  
16 interconnect to a server --

17 JUDGE MacDONALD: Which claim is that?

18 MR. KAPLAN: Claim 11 of Erpeldinger. "Executing a  
19 software distribution application on the work station, establishing a network  
20 session with the server," i.e., the client is logging onto the server,  
21 notwithstanding that the distribution is coming the other way.

22 The teaching away, and this is the part -- we didn't cite claim 11  
23 in our brief -- the teaching away is what that is talking about is you launch  
24 an application on the client, the client connects to the server.

25 JUDGE MacDONALD: I'm sorry. I'm not seeing this.

26 JUDGE CHEN: Are you talking about claim 12?

27 MR. KAPLAN: I'm sorry, it's claim 12. I made a mistake. It's  
28 claim 12 of Erpeldinger.

29 JUDGE MacDONALD: Thank you. Which line?

30 MR. KAPLAN: You can start with the preamble, "A method of  
31 changing a current operating system to a new operating system in a work

1 station," and in the first and second storage device, using a data transmission  
2 to interconnect to the server.

3 If you look at the steps, there is a software application launched  
4 on the client, that is Step A. That software application in Step B of claim 12  
5 then itself establishes the connection to the server, and then the software  
6 distribution goes the other way.

7 The Examiner is citing that the application on the server that  
8 distributes the software is launched by the server. We don't dispute that.  
9 We're talking about prohibiting -- the access is going the other way. With  
10 regard to the teach away, and I would ask for you to account for this if you're  
11 going to combine it, there is a specific teach away here on this application,  
12 and let me point you back to Column 1 in Erpeldinger, beginning at line 55  
13 through Column 2, around line 12 or 13.

14 It's a little lengthy. I won't read it. Let me summarize for you  
15 so you can account for it sort of off line as to what it says.

16 What Erpeldinger is saying is in order to have these operating  
17 systems updated from the server to the client, you have to have the  
18 application trigger on the client to connect to the server, and the problem  
19 that creates is that application itself on the client uses the operating system  
20 on the client, and he explains that if you then want to update the operating  
21 system, you can't do it because the application on your client that is going to  
22 connect and access the server to do the update needs the present operating  
23 system.

24 What the rest of the Erpeldinger patent is about, it's like the  
25 trapped door in the spacecraft, where they open the outside, they let you in,  
26 then they close the outside and let you into the inside, what Erpeldinger is  
27 saying is because the application on my client is needed in order to connect  
28 to the server and download the update, if the update on downloading is an  
29 update to the operating system, and I need the operating system to run my  
30 client's application, I have a problem.

31 What he says is use the present operating system, if you want to  
32 update the operating system on the client, use it to run the application on the

1 client that connects to the server, download the updating operating system to  
2 a back-up storage place, and then when you re-boot the system, load that  
3 updated operating system in instead of the present one.

4 This is critical, Judge, because the reason he's doing that is  
5 because -- he explains it there at the bottom of Column 1. He has to have  
6 that application on the client to connect to the server. He's teaching we need  
7 something on the client to go log into the server to get the update.

8 That's completely opposite from what we are saying. What we  
9 are saying -- the Examiner is equating, and he does this very clearly in his  
10 brief, that the flow of software update comes one way to mean that there  
11 must be a way that it logs on, but this is not what this is teaching. This is  
12 teaching that the whole purpose of this invention is because you have to log  
13 on from the client to the server and you need the application to do that.

14 I think -- again, I haven't seen your 103, I haven't even seen the  
15 reference -- I think that has to be accounted for, where one says it would be  
16 obvious to just flip it the other way. Number two, and this goes to your  
17 prohibiting discussion before, even if you were to disregard everything I just  
18 said and you assumed the log on went the other way, which is incorrect, we  
19 would submit, if you assume the log on went the other way, you still have  
20 this situation where our claim, which calls for separating, and to ones that  
21 require the trust one way and one the other way, sometimes the first set of  
22 servers prohibits it, that's what you raised, the later claims, I would argue  
23 equivalently, but they talk about separating the separate services into ones  
24 where the trust goes this way and one where the trust goes that way.

25 JUDGE MacDONALD: I was reading that to be really the  
26 one-way trust, because there is no other version.

27 MR. KAPLAN: I agree. Those were just different ways of  
28 saying one-way trusts, but the point is even if you read Erpeldinger, the  
29 Examiner's rejection goes, we think, logically, something like this.

30 A server might log on one way. It doesn't say anything about it,  
31 and since the software goes one way, it must log on from the server to the  
32 client. There is another system that says e-mail, it must go the other way.



1           Because of the separating and prohibiting language, if you have  
2 a server that is going one way or if you have a different server that's going  
3 the other way, all the other servers that the client is connected to, none of  
4 them go two ways, and none of them provide any of those intermixed  
5 services.

6           That, too, is taught against. If you look in Column 1 of the  
7 Erpeldinger patent, Erpeldinger says around line -- first of all, he clearly  
8 treats, starting at line 23 through 37, he clearly treats all the services the  
9 same. He doesn't talk about separating one or the other.

10           Here's the other point, and this is likely in our view to just  
11 maximize the efficiency, the key line is at lines 28/29, "Depending on the  
12 implementation," that line in Column 1.

13           "A server may provide several services or types of services."  
14 That is what is typically done. You may have a server that is doing e-mail or  
15 software distribution or updates, whatever he's talking about. That does not  
16 teach, and we would submit it teaches the opposite of going through specific  
17 services and saying these can only be provided from a server where the log  
18 on goes or the trust goes one way from the client to the server, and these  
19 other ones can only go from the server to the client, so when you take all that  
20 together, and this to us sort of summarizes it, and I would ask for you to  
21 account for this, even under 103 -- what the Examiner is really saying is  
22 there is a service here that I think can be implemented by having the client  
23 log onto the server. That would be the software distribution he cites, even  
24 though we don't think that is correct.

25           There is another service like e-mail where the client logs onto  
26 the server. If you had those two and if you didn't implement anything else  
27 on those servers, and if you had no other servers providing services to the  
28 client, coincidentally, you would have a situation where you would only  
29 have two servers and one logged on one way and the other one was logged  
30 on another way.

31           What we are saying is that's just a matter of trying to come up  
32 with a combination -- none of that is in this reference. You could have an

1 one in a million happenstance that a situation where something logged on  
2 one way and something logged on the other way, but that is not fairly taught  
3 by a reference that says here's a bunch of servers, provide the services and  
4 you can provide multiple ones from each server.

5 JUDGE MacDONALD: I think also in the section you were  
6 citing, I would agree that particular paragraph, which is why you were  
7 discussing the rest of the reference was so important, what is being provided  
8 there for services are all of the type where if you did construct the one-way  
9 trust, they would all point in the same direction.

10 MR. KAPLAN: I would agree.

11 JUDGE MacDONALD: The software distribution is critical  
12 because that would go the other way except as you pointed out, it isn't quite  
13 what the Examiner has said.

14 MR. KAPLAN: I would say that's generous.

15 JUDGE MacDONALD: I have no other questions unless the  
16 other Judges have questions.

17 MR. KAPLAN: May I just check my notes? I think I am done.

18 JUDGE MacDONALD: I think you have convinced me to  
19 leave this to the Examiner. I will give him the Brown reference, is what I  
20 am going to recommend. If they want to do something, they may. I won't  
21 be proposing a rejection.

22 MR. KAPLAN: Thank you very much.

23 JUDGE MacDONALD: Thank you.

24 (Whereupon, at 1:52 p.m., the proceedings were concluded.)

25 \* \* \* \* \*